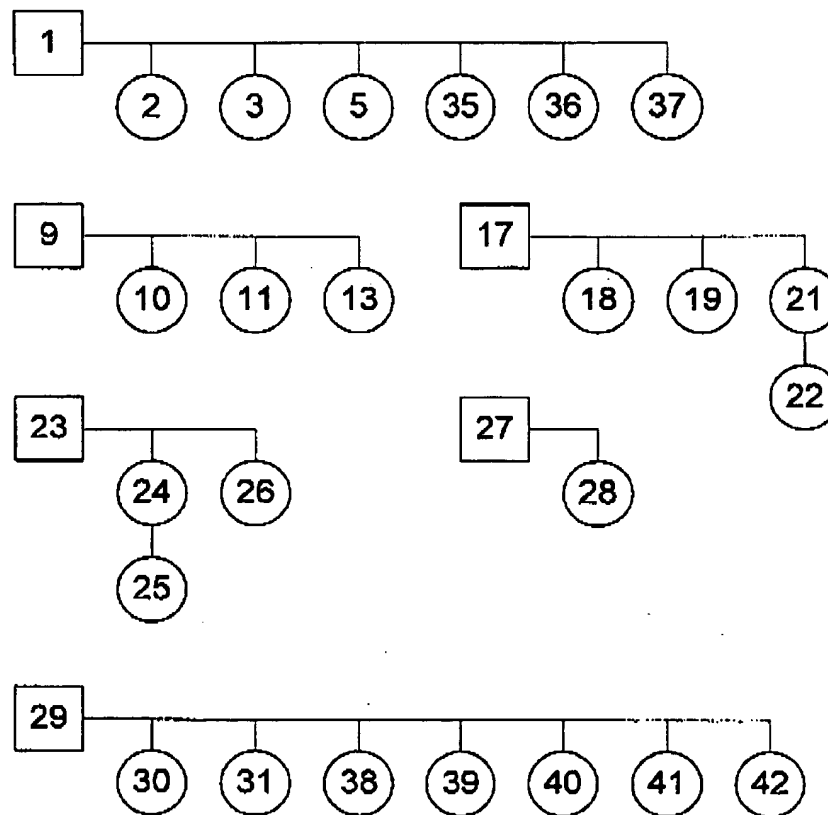


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REMARKS

Reconsideration of the application is respectfully requested. A final Office action mailed July 21, 2004 is pending in the application. Applicants have carefully considered the Office action and the references of record. In the Office action, claims 1-3, 5, 9-11, 13 and 23 were rejected under 35 U.S.C. § 102, and claims 17-19, 21-22, 24-32 were rejected under 35 U.S.C. § 103. In this response to the Office action, claims 1, 9, 17, 23, 27 and 29-31 have been amended. Claims 35-42 have been added. Claims 1-3, 5, 9-11, 13, 17-19, 21-31 and 35-42 are now pending in the application. The following diagram depicts the relationship between the independent and dependent claims.



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Rejections Under 35 U.S.C. § 102 of the Independent Claims

Each of the independent claims 1, 9 and 23 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,706,457 to Dwyer et al (hereinafter *Dwyer*). The Manual of Patent Examining Procedure (M.P.E.P.) states that a claim is anticipated by a reference only if each and every element as set forth in the claim can be found in the reference and, furthermore, that the identical invention must be shown in as complete detail as is contained in the claim.

A claim is anticipated **only** if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. ... The identical invention must be shown in as complete detail as is contained in the ... claim.

(M.P.E.P. § 2131, subsection titled "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM," emphasis added). Each of the independent claims 1, 9 and 23 as amended includes at least one feature that cannot be found in *Dwyer*. For at least this reason, the rejection under 35 U.S.C. § 102(b) of each independent claim 1, 9 and 23 should be withdrawn. Examples of claim features that cannot be found in *Dwyer* are given below for each of the independent claims 1, 9 and 23.

Independent claim 1 is directed to a method for transferring an image from an imaging source device. The method of independent claim 1 requires steps that include acquiring the image from the imaging source device with a still image processing layer and automatically transferring the image thus acquired. The still image processing layer of independent claim 1 is required to include one or more programmatic objects corresponding to the imaging source device as well as an imaging source device manager object.

Acquiring the image from the imaging source device with a still image processing layer comprising at least one programmatic object corresponding to the imaging source device and an imaging source device manager object ...

automatically transferring the acquired image.

(Independent claim 1, as amended, emphasis added). *Dwyer* does not teach such steps, at least because *Dwyer* does not teach a still image processing layer that includes one or more programmatic objects corresponding to the imaging source device and an imaging source device manager object. Figure 2 of *Dwyer* shows "a main display screen or menu of the image display system" (*Dwyer*, column 3, lines 30-31) but, for the purposes of

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applying the *Dwyer* reference to the claims, this is not comparable to a still image processing layer as described in the specification, for example, with reference to Figure 6 ("a block diagram of the software architecture," the specification, page 3, line 17). *Dwyer* thus fails to teach each and every element of independent claim 1 in as complete detail as is contained in the claim.

Independent claim 9 is also directed to a method for transferring an image from an imaging source device. The method of independent claim 9 requires steps that include registering one or more plug-in modules, obtaining data from each registered plug-in module and displaying a user interface menu that includes the obtained data. Each plug-in module corresponds to one or more possible destinations for the image, and the data obtained from each registered plug-in is required by independent claim 9 to include text and one or more icons indicative of those destinations.

Registering at least one plug-in module, each registered plug-in module corresponding to at least one possible destination;
obtaining data from each registered plug-in module indicating the at least one possible destination ... wherein the data ... comprises text and at least one icon;
displaying a user interface menu, the user interface menu comprising the data.

(Independent claim 9, as amended, emphasis added). *Dwyer* does not teach these steps, at least because *Dwyer* does not mention plug-in modules. *Dwyer* thus fails to teach each and every element of independent claim 9 in as complete detail as is contained in the claim. Please see also the discussion below with respect to the rejection of independent claim 29 under 35 U.S.C. § 103(a).

Independent claim 23 is directed to a system for transferring an image from an imaging source device. The system of independent claim 23 is required to include a still image processing layer and an image helper program module. The still image processing layer of independent claim 23 is required to include one or more programmatic objects corresponding to the imaging source device and an imaging source device manager object. The image helper program module automatically transfers images acquired with the still image processing layer.

A still imaging processing layer for acquiring the image ... which comprises at least one programmatic object corresponding to the imaging source device and an imaging source device manager object;

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an image helper program module ... to automatically transfer the acquired image.

(Independent claim 23, as amended, emphasis added). *Dwyer* does not teach such a system, at least because *Dwyer* does not teach a still image processing layer that includes one or more programmatic objects corresponding to the imaging source device and an imaging source device manager object. *Dwyer* thus fails to teach each and every element of independent claim 23 in as complete detail as is contained in the claim.

Rejections Under 35 U.S.C. § 103 of the Independent Claims

Each of the independent claims 17, 27 and 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over combinations of *Dwyer*, U.S. Patent No. 6,509,910 to Agarwal et al. (hereinafter *Agarwal*), U.S. Patent No. 5,809,145 to Slik et al. (hereinafter *Slik*), and U.S. Patent No. 5,796,393 to MacNaughton et al. (hereinafter *MacNaughton*). The M.P.E.P. further states that, to support the rejection of a claim under 35 U.S.C. § 103(a), each feature of each rejected claim must be taught or suggested by the applied prior art, and that each of the words describing the feature must be taken into account.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. ... All words in a claim must be considered in judging the patentability of that claim against the prior art.

(M.P.E.P. § 2143.03, emphasis added). Each of the independent claims 17, 27 and 29 as amended herein includes at least one feature not taught or fairly suggested by *Dwyer*, *Agarwal*, *Slik*, or *MacNaughton* alone or in combination with the prior art of record and is therefore patentable for at least this reason. Examples of claim features missing from *Dwyer*, *Agarwal*, *Slik*, and/or *MacNaughton* are given below for each of the independent claims 17, 27 and 29.

As for independent claim 1, independent claim 17 is directed to a method for transferring an image from an imaging source device that requires steps including acquiring the image from the imaging source device with a still image processing layer and automatically transferring the image thus acquired. Also as for independent claim 1, neither *Dwyer*, nor any of the prior art of record, alone or in combination, teach or fairly suggest the still image processing layer of independent claim 17, in particular, a still image processing layer that is required to include programmatic objects corresponding to

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imaging source devices and an imaging source device manager object as described by the specification. The failures of *Dwyer* are described above in more detail with reference to independent claim 1. *Agarwal* mentions an "interface block ... [that] receives ... image data from [external input devices]" (*Agarwal*, col 4, lines 11-13) but, for the purposes of applying the reference to the claims, gives no comparable details of the structure of the interface block. *Slik* and *MacNaughton* are not concerned with a method having integral image acquisition by a still image processing layer and thus are silent with respect to still image processing layer details. It can be seen that neither *Dwyer*, *Agarwal*, *Slik*, nor *MacNaughton*, alone or in combination, teach or fairly suggest each feature of independent claim 17.

Independent claim 27 is directed to a computer-readable medium storing an image helper program and one or more plug-ins. Independent claim 27 requires that each plug-in is configured to register with a programming interface of the image helper program and also that the image helper program displays a menu of possible destinations for an image. The menu of possible destinations includes data (including text and one or more icons) that is obtained from each registered plug-in.

Each plug-in ... configured to register with the programming interface of the image helper program ...

the image helper program including instructions to (a) obtain from each registered plug-in data indicating the possible destination with which the plug-in is associated, where the data indicating the possible destination comprises text and at least one icon; and (b) display a menu of possible destinations for user selection, where the menu comprises the data.

(Independent claim 27, as amended, emphasis added). *Slik* is cited by the Office action as teaching plug-in modules, but even if, for the purposes of applying the reference to the claims, the "requester modules" of *Slik* are construed as a plug-in module, the requester modules of *Slik* do not have the relationship with the image helper program required by independent claim 27. In particular, no program, such as an image helper program, displays a menu of possible destinations built with data including text and one or more icons obtained from the requester modules of *Slik*. *Dwyer* is cited by the Office action as teaching an image helper program, but *Dwyer* is silent with respect to plug-in modules and thus cannot teach the claimed relationship between the image helper program and plug-in modules. *Agarwal* and *MacNaughton* are similarly silent with respect to plug-in modules and plug-in module

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architecture. As a result, neither *Dwyer*, *Agarwal*, *Slik*, nor *MacNaughton*, alone or in combination, teach or fairly suggest each feature of independent claim 27.

Independent claim 29 is directed to a method for transferring an image from an imaging source device. As for independent claim 9, the method of independent claim 29 requires steps that include registering one or more plug-in modules, obtaining data from each registered plug-in module and displaying a user interface menu that includes the obtained data. Each plug-in module corresponds to one or more possible destinations for the image, and the data obtained from each registered plug-in includes text and one or more icons indicative of those destinations.

Registering at least one plug-in module, each registered plug-in module corresponding to at least one possible destination;

obtaining data from each registered plug-in module indicating the at least one possible destination to which the plug-in module corresponds, where the data includes text and at least one icon;

displaying a user interface menu, the user interface menu comprising the data.

(Independent claim 29, as amended, emphasis added). *Dwyer* does not teach these steps, at least because *Dwyer* does not mention plug-in modules and thus cannot teach registering plug-in modules, obtaining data from plug-in modules or displaying a user interface menu including data obtained from plug-in modules. *Slik* is cited by the Office action as teaching plug-in modules, but even if, for the purposes of applying the reference to the claims, the requester modules of *Slik* are construed as plug-in modules, *Slik* does not teach steps incorporating requester modules as required by independent claim 29. In particular, *Slik* does not describe obtaining data that indicates possible image destinations from each registered plug-in module to be displayed in a user interface menu. *Agarwal* and *MacNaughton* are silent with respect to plug-in modules and plug-in module architecture. As a result, neither *Dwyer*, *Agarwal*, *Slik*, nor *MacNaughton*, alone or in combination, teach or fairly suggest each feature of independent claim 29.

Although independent claims 1, 9 and 23 stand rejected under 35 U.S.C. § 102(b) and not 35 U.S.C. § 103(a), arguments similar to those made above with respect to independent claims 17, 27 and 29 would apply if any of independent claims 1, 9 or 23 were to be rejected under 35 U.S.C. § 103(a). Rejection of independent claim 1, 9 or 23

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over a combination of *Dwyer, Agarwal, Slik, MacNaughton*, or any of the prior art of record, is thus inappropriate.

Newly Added Claims

Claims 35-42 have been added in this amendment to more particularly point out and distinctly claim the invention as described by the specification. In compliance with 37 C.F.R. § 1.121(f), they do not add new matter.

The Remaining Dependent Claims

Each of claims 1, 9, 17, 23, 27 and 29 is in independent form, whereas all of the remaining claims depend directly or indirectly on one of these six independent claims. The dependent claims are allowable for at least the same reasons that the six independent claims 1, 9, 17, 23, 27 and 29 are allowable in that the dependent claims incorporate the features of the independent claims. Nevertheless, the dependent claims further define subject matter not shown or rendered obvious by the prior art of record. Because the independent claims are allowable over the applied prior art, applicants do not believe remarks addressing this further subject matter are necessary herein.

CONCLUSION

The application is considered in good and proper form for allowance, and the examiner is respectfully requested to pass this application to issue. If, in the opinion of the examiner, a telephone conference would expedite the prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,



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